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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,235	08/25/2005	Atsushi Yamashita	2005_0258A	7136

52349 7590 03/22/2007

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EXAMINER	
RUSSELL, CHRISTINA MARIE	
ART UNIT	PAPER NUMBER
2837	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/525,235	YAMASHITA ET AL.	
	Examiner	Art Unit	
	Christina Russell	2837	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-32 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-32 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 22 February 2005 is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 2/05, 6/05, 12/05, and 2/06.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

2. In Figure 18, the reference character S504 is shown but not mentioned in the Specification.

3. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 32 recites the limitation "the apparatus" in line 6 of the claim. There is insufficient antecedent basis for this limitation in the claim. There is no previous mention of an apparatus in the independent claim 32.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 32 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 32 claims a program, which when not stored on a computer readable medium is considered non-statutory. Also, the claim 32 is claiming a program, yet it has the computer apparatus performing the steps.

Double Patenting

8. Claims 1-32 of this application conflict with claims 1, and 10-40 of Application No. 11/053928. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

9. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

10. Claims 31 and 32 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 39 and 40 of copending Application No. 11/053928. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 10-38 of copending Application No. 11/053928. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

13. In terms of claim 1, the copending application 11/053928 teaches in its claim 1, a control system for controlling an operation of at least one apparatus, comprising: a rhythm input section of outputting, as an input rhythm signal, an electrical signal whose amplitude level varies depending on a physical motion of a user, the physical motion corresponding to a pronunciation pattern of a name indicating the contents of a control of the apparatus; a rhythm dictionary storage section of storing a rhythm dictionary table for associating the contents of the control of the apparatus with a registered rhythm

pattern typifying the pronunciation pattern of the name indicating the contents of the control; and a control section of controlling the operation of the apparatus, wherein the control section comprises: an input rhythm pattern recognition means of analyzing the input rhythm signal input from the rhythm input section to recognize an input rhythm pattern; and an apparatus control means of referencing the rhythm dictionary table to search for a registered rhythm pattern matching the input rhythm pattern recognized by the input rhythm pattern recognition means, and based on the contents of the control corresponding to the registered rhythm pattern, controlling the apparatus.

14. The copending application 11/053928 does not however teach the physical motion of a user as a tap input. It is however obvious, to one of ordinary skill in the art, that a tap input produced by a user can be considered a physical motion, seeing how in order to produce a tapping input the user must physically move their finger.

15. As for claim 2, dependent upon claim 1, the copending application 11/053928 teaches word for word what claim 2 teaches in the copending application's claim 10.

16. As for claim 3, dependent upon claim 2, the copending application 11/053928, teaches in claim 11, the input rhythm recognition means recognizes a beat timing and/or a silent beat timing based on the temporal change in the amplitude level, but does not teach the beat timing being the user tapping the rhythm input section and the silent beat timing being the recognition of no tapping. It would have been obvious, that since claim one of the copending application states that the input rhythm pattern corresponds to a user's physical motion, and it has already been discussed that a tapping motion from

the user is a physical motion, that the beat timing of the rhythm pattern would be that of the users tapping or physical motion, or lack thereof for a silent beat timing.

17. As for claim 4, similar to copending application claim 12, it is again obvious to interpret a tapping motion as a physical motion.

18. As for claim 5, the copending application 11/053928 teaches in claim 13 a HIGH-level electrical signal is continuously output from the rhythm input section for the predetermined time interval, and since claim 1 of the copending application states that the electrical signal is dependent upon a user's physical motion, it is obvious that a user's continuous pressing is a physical motion and therefore would effect the electrical signal for the predetermined time interval.

19. As for claims 6 and 7, the copending application recites word for word the claimed elements in its own claims 14 and 15.

20. As for claims 8 and 9, the copending application teaches in claims 16 and 17, an input rhythm pattern, and a motion, weak and strong, which has already been determined as the user's input tapping pattern.

21. As for claims 10-12, the copending application recites word for word the claimed elements in its own claims 18-20.

22. As for claim 13, the copending application again teaches, in its claim 21, a motion, weak and strong, which has already been defined as the user's tapping.

23. As for claim 14, the copending application recites word for word the claimed elements in its own claim 22.

24. As for claim 15, the copending application again teaches, in its claim 23, a motion, weak and strong, which has already been defined as the user's tapping.

25. As for claims 16 and 17, the copending application recites word for word the claimed elements in its own claims 24 and 25.

26. As for claims 18-30, the copending application 11/053928 teaches these claimed elements in its own claims 26-38, but with a motion and not a tapping, which has already been determined as an obvious interpretation, dependent upon claim 10, which is equivalent to the present application's claim 2, and not on claim 1. This still would have been considered obvious since all the limitations are encompassed within the dependent claims, which through claim 10 are dependent upon independent claim 1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christina Russell whose telephone number is 571-272-4350. The examiner can normally be reached on Mon-Fri, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lincoln Donovan can be reached on 571-272-1988. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CR
9/19/2006

LINCOLN DONOVAN
SUPERVISORY PATENT EXAMINER